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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,895	07/12/2001	Hisashi Tanaka	P/1878-172	2005

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EXAMINER
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HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/903,895

**Applicant(s)**

TANAKA ET AL.

**Examiner**

Doug Hutton

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 10-12, 16-18 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 13-15 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of Invention #1 in the reply filed on 24 November 2004 is acknowledged.

Claims 4-6, 10-12, 16-18 and 22-24 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Objections***

Claim 13 is objected to because of the following informalities:

- the term "said" in Line 8 should be amended to — a — because no "display information database" is previously mentioned in the claim.

Claim 19 is objected to because of the following informalities:

- the term "program" in Line 4 should be amended to — method — because the subsequent limitations of the claim refer to the method performed by the computer program.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

***Claims 19-21:***

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 19-21 recite a “computer program” that includes method steps. However, none of the claims recite that the computer program is “tangibly embodied” and thus the recited invention is not “concrete.”

To obviate these rejections, Applicant may amend the phrase “computer program” in Claim 19, Line 1 to read — computer program embodied on a recordable computer-readable medium —.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*Claims 7-9:*

Claim 7 recites the limitation “a display information database **previously** storing a plurality of pieces of display information” in Lines 5-6. This limitation is indefinite because it is unclear how the “display information” is “**previously** stored.” It is clear that the “display information” is stored in the database. However, the question is: the “display information” is stored **previous** to what? Asked differently, what specific act is performed **after** the “display information” is stored?

Applicant must amend the claim to particularly point out and distinctly claim the invention. For purposes of examination, the examiner will assume: 1) the “plurality of pieces of display information” are different versions of the homepage for a website; and 2) the database stores the different versions prior to the customer’s visit to the website.

Claims 8 and 9 are also indefinite because they include this limitation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Paltenghe et al., U.S. Patent No. 6,421,729.

*Claim 1:*

Paltenghe discloses a method of displaying a page on a user terminal by a server when said user terminal establishes a connection to said server through a network (see Column 1, Lines 29-35 – Paltenghe discloses this limitation in that, in the “Background of the Invention,” it discloses the use of the Internet for online commerce), said method comprising the steps of:

- previously preparing a plurality of pages each corresponding to a customer level (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes different homepages for “known” users and “unknown” users); and
- when said user terminal accesses said server, selecting and displaying one of said previously prepared pages corresponding to a current customer level of a user of said user terminal (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system allows the user to determine whether a cookie corresponding to a website is stored on the user’s computer, and, if so, upon any subsequent access of the website server, allows

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the user to determine whether to release the cookie to the website server. If the user opts to release the cookie to the website server, then the user is a “known” user, and the website server delivers the “personalized” version of the homepage. If the user opts not to release the cookie to the website server, then the user is an “unknown” user, and the website server delivers the “new user” version of the homepage. Thus, the “customer levels” include “known” customers and “unknown” customers.).

*Claim 2:*

Paltenghe discloses the method according to Claim 1, wherein said page is a page initially displayed when said user terminal makes access to said server (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the website server determines the user’s “customer level” upon initially accessing the website server).

*Claim 3:*

Paltenghe discloses the method according to Claim 1, wherein the layout of said page is changeable by operations through said user terminal (see Column 8, Lines 44-64 – Paltenghe discloses this limitation in that the web page display system allows the user to determine when a cookie is returned to the corresponding website; the user may select from numerous options and may amend the selection).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9, 13-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, in view of Niu et al., U.S. Patent Application Publication No. US 2002/0062245.

***Claim 7:***

Paltenghe discloses a page display system (see Column 1, Lines 29-35 – Paltenghe discloses this limitation in that, in the “Background of the Invention,” it discloses the use of the Internet for online commerce), comprising:

- a user terminal connected to a network (see Column 7, Lines 12-16 – Paltenghe discloses this limitation in that the web page display system includes a user PC with a browser for surfing the Internet);
- a display information database previously storing a plurality of pieces of display information corresponding to customer levels (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes different homepages for “known” users and “unknown” users. The system allows a user to determine whether a cookie corresponding to a website is stored on the user’s computer, and, if so, upon any subsequent access of the website server,



allows the user to determine whether to release the cookie to the website server.

If the user opts to release the cookie to the website server, then the user is a "known" user. If the user opts not to release the cookie to the website server, then the user is an "unknown" user. Thus, the "customer levels" include "known" customers and "unknown" customers.); and

- a server for reading, when a user makes access thereto, a customer level currently stored for said user (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes different homepages for "known" users and "unknown" users. Upon the user accessing the website, the server attempts to read the cookie to determine the "customer level." However, the system allows a user to determine whether a cookie corresponding to a website is stored on the user's computer, and, if so, upon any subsequent access of the website server, allows the user to determine whether to release the cookie to the website server. If the user opts to release the cookie to the website server, then the user is a "known" user, and the website server delivers the "personalized" version of the homepage. If the user opts not to release the cookie to the website server, then the user is an "unknown" user, and the website server delivers the "new user" version of the homepage. Thus, the "customer levels" include "known" customers and "unknown" customers.), selecting display information corresponding to said customer level of said user from said display information database, and displaying said selected information

on said user terminal (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes a server that attempts to read a stored cookie corresponding to the website. If the user has opted to release the cookie to the website server, then the user is a “known” user, and the website server delivers the “personalized” version of the homepage. If the user has opted not to release the cookie to the website server, then the user is an “unknown” user, and the website server delivers the “new user” version of the homepage.).

Paltenghe fails to expressly disclose:

- a customer information database storing customer information including a customer level for each user; and
- a server for reading a customer level currently stored for said user from said customer information database.

Niu teaches a page display system (see Paragraph 0002 – Niu teaches this limitation in that the system displays promotions on an e-commerce website), comprising:

- a customer information database storing customer information including a customer level for each user (see Paragraphs 0035, 0036, 0041-0045, 0047, 0056 and 0057 – Niu teaches this limitation in that the system stores “clickstream data” for each individual visitor to an e-commerce website in a visitor-specific

data file on the server. Using the visitor-specific data file, the system may send a promotion embedded on the homepage of the e-commerce website. The system is highly customizable in that rules for determining if a promotion is embedded into the e-commerce website and which promotion to embed into the e-commerce website may be based upon whether the visitor is a "first time visitor" or a "frequent visitor." This aspect of the system comprises "customer levels."); and

- a server for reading a customer level currently stored for said user from said customer information database (see Paragraphs 0035, 0036, 0041-0045, 0047, 0056 and 0057 – Niu teaches this limitation in that the system stores "clickstream data" for each individual visitor to an e-commerce website in a visitor-specific data file on the server. Using the visitor-specific data file, the system server may determine if a promotion is embedded into the e-commerce website and which promotion to embed into the e-commerce website based upon whether the visitor is a "first time visitor" or a "frequent visitor."),

for the purpose of providing visitors to an e-commerce website with better service, information and value (see Paragraph 0010).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the page display system, disclosed in Paltenghe, to include:

- a customer information database storing customer information including a customer level for each user; and

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- a server for reading a customer level currently stored for said user from said customer information database,

for the purpose of providing visitors to an e-commerce website with better service, information and value, as taught in Niu.

*Claim 8:*

Paltenghe, in view of Niu, discloses/teaches the system according to Claim 7, wherein said page is a page initially displayed when said user terminal makes access to said server (as indicated in the above rejection for Claim 2, Paltenghe discloses this limitation).

*Claim 9:*

Paltenghe, in view of Niu, discloses/teaches the system according to Claim 7, wherein the layout of said page is changeable by operations through said user terminal (as indicated in the above rejection for Claim 3, Paltenghe discloses this limitation).

*Claim 13:*

Paltenghe discloses a server for displaying a page on a user terminal when said user terminal establishes a connection to said server through a network (see Column 1, Lines 29-35 – Paltenghe discloses this limitation in that, in the “Background of the Invention,” it discloses the use of the Internet for online commerce), wherein said server attempts to read, when a user makes access thereto, a customer level currently stored

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for said user (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes different homepages for “known” users and “unknown” users. Upon the user accessing the website, the server attempts to read the cookie to determine the “customer level.” However, the system allows a user to determine whether a cookie corresponding to a website is stored on the user’s computer, and, if so, upon any subsequent access of the website server, allows the user to determine whether to release the cookie to the website server. If the user opts to release the cookie to the website server, then the user is a “known” user. If the user opts not to release the cookie to the website server, then the user is an “unknown” user. Thus, the “customer levels” include “known” customers and “unknown” customers.), selects display information corresponding to said customer level of said user from display information stored in a display information database, and displays said selected information on said user terminal (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes a server that attempts to read a stored cookie corresponding to the website. If the user has opted to release the cookie to the website server, then the user is a “known” user, and the website server delivers the “personalized” version of the homepage from the server. If the user has opted not to release the cookie to the website server, then the user is an “unknown” user, and the website server delivers the “new user” version of the homepage from the server.).

Paltenghe fails to expressly disclose a server that reads a customer level from a customer information database.

Niu teaches a server for displaying a page on a user terminal when said user terminal establishes a connection to said server through a network (see Paragraph 0002 – Niu teaches this limitation in that the system displays promotions on an e-commerce website), wherein a server reads, when a user makes access thereto, a customer level currently stored for said user from a customer information database (see Paragraphs 0035, 0036, 0041-0045, 0047, 0056 and 0057 – Niu teaches this limitation in that the system stores “clickstream data” for each individual visitor to an e-commerce website in a visitor-specific data file on the server. Using the visitor-specific data file, the system server may determine if a promotion is embedded into the e-commerce website and which promotion to embed into the e-commerce website based upon whether the visitor is a “first time visitor” or a “frequent visitor.”), for the purpose of facilitating the e-commerce website owner’s access to the customer information (see Paragraph 0046).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the server, disclosed in Paltenghe, to read the customer level from a customer information database, for the purpose of facilitating the e-commerce website owner’s access to the customer information, as taught in Niu.

*Claim 14:*

Paltenghe, in view of Niu, discloses/teaches the server according to Claim 13, wherein said page is a page initially displayed when said user terminal makes access to said server (as indicated in the above rejection for Claim 2, Paltenghe discloses this limitation).

*Claim 15:*

Paltenghe, in view of Niu, discloses/teaches the server according to Claim 13, wherein the layout of said page is changeable by operations through said user terminal (as indicated in the above rejection for Claim 3, Paltenghe discloses this limitation).

*Claim 19:*

Paltenghe discloses a computer program for causing a computer to perform a method of displaying a page on a user terminal by a server when said user terminal establishes a connection to said server through a network (see Column 1, Lines 29-35 – Paltenghe discloses this limitation in that, in the “Background of the Invention,” it discloses the use of the Internet for online commerce), said method comprising the steps of:

- previously preparing a plurality of pages each corresponding to customer levels, and when said user accesses said server, attempting to read a customer level currently stored for said user (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe

discloses this limitation in that the web page display system includes different homepages for “known” users and “unknown” users. Upon the user accessing the website, the server attempts to read the cookie to determine the “customer level.” However, the system allows a user to determine whether a cookie corresponding to a website is stored on the user’s computer, and, if so, upon any subsequent access of the website server, allows the user to determine whether to release the cookie to the website server. If the user opts to release the cookie to the website server, then the user is a “known” user. If the user opts not to release the cookie to the website server, then the user is an “unknown” user. Thus, the “customer levels” include “known” customers and “unknown” customers.); and

- selecting and displaying one of said previously prepared pages corresponding to a current customer level of a user of said user terminal (see Column 1, Lines 35-50; see Column 2, Lines 41-56; see Column 7, Lines 12-38; see Column 9, Lines 49-54 – Paltenghe discloses this limitation in that the web page display system includes a server that attempts to read a stored cookie corresponding to the website. If the user has opted to release the cookie to the website server, then the user is a “known” user, and the website server delivers the “personalized” version of the homepage. If the user has opted not to release the cookie to the website server, then the user is an “unknown” user, and the website server delivers the “new user” version of the homepage.).



Paltenghe fails to expressly disclose reading a customer level currently stored for said user when said user terminal accesses said server.

Niu teaches a computer program for causing a computer to perform a method of displaying a page on a user terminal by a server when said user terminal establishes a connection to said server through a network (see Paragraph 0002 – Niu teaches this limitation in that the system displays promotions on an e-commerce website), said method comprising the step of:

- reading a customer level currently stored for said user when said user terminal accesses said server (see Paragraphs 0035, 0036, 0041-0045, 0047, 0056 and 0057 – Niu teaches this limitation in that the system stores “clickstream data” for each individual visitor to an e-commerce website in a visitor-specific data file on the server. Using the visitor-specific data file, the system may send a promotion embedded on the homepage of the e-commerce website. The system is highly customizable in that rules for determining if a promotion is embedded into the e-commerce website and which promotion to embed into the e-commerce website may be based upon whether the visitor is a “first time visitor” or a “frequent visitor.” This aspect of the system comprises “customer levels.”),

for the purpose of providing visitors to an e-commerce website with better service, information and value (see Paragraph 0010).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the computer program, disclosed in Paltenghe, to include:

- reading a customer level currently stored for said user when said user terminal accesses said server,

for the purpose of providing visitors to an e-commerce website with better service, information and value, as taught in Niu.

*Claim 20:*

Paltenghe, in view of Niu, discloses/teaches the computer program according to Claim 19, wherein said page is a page initially displayed when said user terminal makes access to said server (as indicated in the above rejection for Claim 2, Paltenghe discloses this limitation).

*Claim 21:*

Paltenghe, in view of Niu, discloses/teaches the computer program according to Claim 19, wherein the layout of said page is changeable by operations through said user terminal (as indicated in the above rejection for Claim 3, Paltenghe discloses this limitation).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kannan, U.S. Patent Application Publication No. US 2001/0054064; Walter et al., U.S. Patent No. 6,334,110; Barbara et al., U.S. Patent

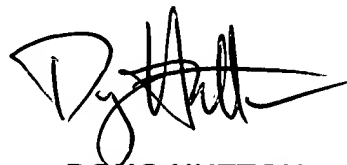
Application Publication No. US 2002/0016769; and Chase, **Active Server Pages 3.0 from Scratch**, Chapter 5 – “*Personalizing the Site Using Cookies and Database Information*” (Que Publishing, printed 1 December 1999).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH  
January 29, 2005

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish extending to the right.

**DOUG HUTTON  
PATENT EXAMINER  
TECH CENTER 2100**